Remarks

The Applicants appreciate the Examiner's thorough review and consideration of the patent application, which resulted in the allowance of Claims 35-51. Claims 1-34 are also pending the patent application. Of these pending claims, only claim 1 and claim 17 are independent claims. Since the Applicants respectfully assert that these independent claims are allowable, claims that depend from claim 1 and claim 17 are also allowable. Thus, Applicants respectfully request favorable reconsideration in view of the subsequent remarks.

In the Office Action dated April 11, 2005 ("Office Action"), claims 17-21, 24-26, 31, and 32 were rejected under 35 U.S.C. 102(e) as being unpatentable over U.S. Patent No. 6,014,694 issued on January 11, 2001 to Aharoni *et al.* ("Aharoni patent"). In order for there to be anticipation, a reference must teach each and every claim element either expressly or inherently. *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631 (Fed. Cir. 1987). Since this requirement has not been met as indicated below, the Applicants respectfully traverse this rejection. Claim 17 is patentable over the Aharoni patent because that patent *does not* disclose the limitations of calculating a step size, deriving a coding difficulty value, and determining the optimum display size, which is more clearly explained below. Since claims 18-21, 24-26, 31, and 32 depend from claim 17 and inherently include all the limitations of that claim, the remarks made with regard to Claim 17 are equally applicable to those dependent claims.

Though suggested in the Office Action, the Aharoni patent in FIG. 9 does not disclose a method for calculating an optimum display size. Instead, the Aharoni patent discloses "a system for adaptively transporting video over networks wherein the available bandwidth varies with time." Thus, this system adjusts a compression ratio depending on the bandwidth. *See* column 2, lines 10-28. In addition, FIG. 9 is a "high level diagram illustrating the sender portion of the video server in more detail." *See* column 11, lines 48-49. The video server includes a rate control unit identified by reference

numeral 106. This "rate control unit keeps track of the amount of video information in terms of time that is queued for display at the client ... The rate control unit uses acknowledges received by the client via the acknowledgment receiver 108 to determine the next packet transmission time." According to column 11, lines 49-53 of the Aharoni patent, the rate control unit 106 is a piece of hardware that measures the bandwidth of the network (see Column 12, lines 20-23). Moreover, FIG. 8 in the Aharoni patent only identifies a sample sequence for a group of pictures made up of various frame types.

Making adjustments based on bandwidth is not equivalent to a method for calculating an optimum display size for a visual object. After a thorough review, the Applicants cannot identify in the Aharoni patent where it discloses calculating a step size for a predetermined number of frames, deriving a coding difficulty value as a function of the step size, and determining an ultimate display size for the visual object based on either the coding difficulty value or a visual object transmission rate. If the Applicants overlooked the section of the Aharoni suggested by the Examiner as anticipatory, the Applicants request that the Examiner more specifically identify this section. In fact, the Aharoni patent does not disclose a method for calculating an optimum display size for a visual object. Therefore, the Aharoni patent does not anticipate independent claim 17 or claims 18-21, 24-26, 31, and 32 that depend from claim 17. With this in mind, the Applicants respectfully request designating these claims as allowed.

In the Office Action, claims 1-5, 8-16, 22, 23, 33, and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Aharoni patent in view of U.S. Patent No. 6,310,909 issued on October 30, 2001 to Jones ("Jones patent"). For a *prima facie* case of obviousness, there must be a motivation to modify the reference or combine reference teachings, and the cited references must teach or suggest **all** of the claim limitations *with* a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Aharoni patent in view of the Jones patent does not make independent claim 1 or independent claim 17 obvious because the requirements for obviousness have

not been met. Consequently, dependent claims 2-5, 8-16, 22, 23, 33, and 34 are not obvious since they include all the limitations of the respective independent claim.

The Aharoni patent in view of the Jones patent does not make independent claim 1 or independent claim 17 obvious for at least the reason that all the claim limitations have not been met. As mentioned above with reference to claim 17, the Aharoni patent does not teach calculating a step size for a predetermined number of frames, deriving a coding difficulty value as a function of the step size, and determining an ultimate display size for the visual object based on either the coding difficulty value or a visual object transmission rate. In fact, the Aharoni patent does not even suggest these limitations. Similarly, the Aharoni patent neither teaches nor suggests the following limitations of Claim 1: compressing a visual object with a visual object encoder for a predetermined number of frames of the visual object; calculating one or more signal-to-noise ratios; calculating a coding difficulty value as a function of the one or more calculated signal-to-noise ratios; and determining the optimum display size for the visual object based on at least one of the coding difficulty value and a visual object transmission rate. Like the Aharoni patent, the Jones patent neither teaches nor suggests any of the limitations in claim 1 or claim 17 as described below.

Even if the Aharoni patent in view of the Jones patent did teach or suggest all the limitations in claim 1 and claim 17, there is no motivation for modifying these documents in a way that makes claim 1 and claim 17 obvious. Because the motivation to modify the Aharoni patent and Jones patent is not readily apparent and missing from the Office Action, these patents cannot make claim 1 or claim 17 obvious. Moreover, there cannot be a motivation to modify because the problems solved in the Aharoni patent and Jones patent are very different than the problem solved by claim 1 and claim 17. In fact, the Aharoni patent discloses, "a system for adaptively transporting video over networks wherein the available bandwidth varies with time." *See* column 2, lines 10-12. The Jones patent encompasses a method and apparatus for enhancing the bit rate and/or margin at which quadrature amplitude

modulated (QAM) communication is performed. *See* column 4, lines 1-3. Neither of these patents describes a method for calculating an optimum display size, as described in claim 1 and claim 17. Consequently, the motivation requirement for prima facie obviousness is missing.

An obviousness rejection is unfounded in the absence of a suggestion/motivation, a teaching or suggestion of all of the claim limitations, or a reasonable expectation of success. As described above, the first two requirements are clearly missing from the Aharoni patent in view of the Jones patent. In addition, the reasonable expectation of success requirement is also missing. The Office Action does not include and the Applicants can not identify any reasonable expectation of success. Since the requirements for obviousness under 35 U.S.C. 103(a) have not been satisfied, the Applicants respectfully assert that claims 1-5, 8-16, 22, 23, 33, and 34 are in a condition for allowance and request removal of the obviousness objection.

In light of the above-mentioned remarks, claims 1-34 are in a condition for allowance. Consequently, the Applicant respectfully requests that the claims be allowed and the current application is sent to issuance.

A fee of **$510.00** for a three-month extension of time filing fee is due. The Commissioner is hereby authorized to apply this fee and any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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